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09/482,235 01/13/00 WOOD

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HM12/0727

EXAMINER

COLEMAN, R

ART UNIT

PAPER NUMBER

1624

DATE MAILED:

07/27/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/482,235**

Applicant(s)  
**WOOD et al.**

Examiner  
**Brenda Coleman**

Art Unit  
**1624**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on May 29, 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 20) ☐ Other:

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### **DETAILED ACTION**

Claims 1-20 are pending in the application.

#### ***Election/Restriction***

1. Applicant's election with traverse of Group I in Paper No. 4 is acknowledged. However, upon further consideration the product by process claims of claims 9, 10 and 20 will be rejoined with the process claims of Group I.

#### ***Priority***

2. It is recognized benefit under 35 USC 120 is being urged. However, instant application is only entitled to benefit of serial number 09/206,082 filed December 4, 1998 as it is only completely described in said parent. Note *In re Scheiber* 199 USPQ 782 regarding 112 compliance for benefit under 35 USC 120.

Application Serial Number 09/482,235 is a divisional of Wood et al. U.S. Serial Number 09/206,082 filed December 4, 1998 now U.S. Patent Number 6,037,468; which is a CIP of U.S. Serial Number 08/817,230 filed June 4, 1997 now abandoned; as the U.S. national phase entry under 35 U.S.C. 371 of PCT/IB96/00987, which had an international filing date of August 9, 1996, claiming benefit of U.S. application serial number 60/002,164 filed August 11, 1995. Wood et al. U.S. Serial Number 09/482,235 is entitled to the benefit of Wood et al. U.S. Serial Number 09/206,082, however they are not entitled to benefit of Serial Number 08/817,230. Rule 78 states that "each prior application must name as an inventor at least one inventor named in the

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later filed nonprovisional application” and “disclose the named inventor’s invention claimed in at least one claim of the later filed nonprovisional application in the manner provided by the first paragraph of 35 U.S.C. 112. In order for applicant to get priority of serial number 08/817,230, or subsequent parents, there must be at least one inventor in common and disclose the named inventor’s invention claimed in at least one claim. The application 08/817,230 names the following common inventors John L. Wood and Brian M. Stoltz, however the invention being claimed in this application serial number 09/482,235 is not disclosed in 08/817,230. Applicant’s attention is drawn to the definition of R.

### *Specification*

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. **It is important that the abstract not exceed 150 words in length.** The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

4. The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner

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representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 6-8, 10-12, 18 and 19 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The definition of R where R is methyl, CO<sub>2</sub>CH<sub>3</sub>, dimethoxybenzyl, paramethoxybenzyl or benzyl is not defined in the specification with respect to the processes of claims 1 and 17.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

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- a) Claims 1-7 and 9-20 are vague and indefinite in that it is not known what is meant by the variable X in the two formulae in the 5 line of claim 1. There is no definition for the variable X in the claim.
- b) Claims 6 and 18 recite the limitation "Me" in the definition of R. There is insufficient antecedent basis for this limitation in the claim.
- c) Claims 6 and 18 recite the limitation "CO<sub>2</sub>Me" in the definition of R. There is insufficient antecedent basis for this limitation in the claim.
- d) Claims 6 and 18 recite the limitation "DMB" in the definition of R. There is insufficient antecedent basis for this limitation in the claim.
- e) Claims 6 and 18 recite the limitation "PMB" in the definition of R. There is insufficient antecedent basis for this limitation in the claim.
- f) Claims 6 and 18 recite the limitation "Bn" in the definition of R. There is insufficient antecedent basis for this limitation in the claim.
- g) Claim 7 recites the limitation "Me" in the definition of R. There is insufficient antecedent basis for this limitation in the claim.
- h) Claim 7 recites the limitation "CO<sub>2</sub>Me" in the definition of R. There is insufficient antecedent basis for this limitation in the claim.
- i) Claim 8 recites the limitation "Me" for the variable R in the furanose structure. There is insufficient antecedent basis for this limitation in the claim.

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- j) Claim 8 recites the limitation "O" for the variable X in the furanose structure.  
There is insufficient antecedent basis for this limitation in the claim.
- k) Claim 8 recites the limitation " $\text{H}_3\text{C}$ " for the variable R in the structural formulae on page 27, line 1. There is insufficient antecedent basis for this limitation in the claim.
- l) Claims 11 and 19 recite the limitation "K252a". There is insufficient antecedent basis for this limitation in the claim.
- m) Claim 12 recites the limitation " $\text{H}_3\text{C}$ " for the variable R in the structural formulae of claim 12. There is insufficient antecedent basis for this limitation in the claim.
- n) Claim 12 recites the limitation " $\text{HO-CH}_2$ " in the second structural formula. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 6-8 and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Wood et al., Tetrahedron Letters. Wood teaches the process and the product by process of the instant invention. See reaction Scheme 1 and the first paragraph which states that "the enantioselective

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synthesis of (+)-K252a [5] via an approach involving the late-stage coupling of aglycon 8 and furanose 9".


8. Claims 6-8 and 10-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Wood et al., Journal of the American Chemical Society. Wood teaches the process and the product by process of the instant invention. See reaction Scheme 1 and paragraphs 1 and 2 which teaches the reaction of compounds 6 and 3 to obtain 1 and the reaction of compounds 4 and 5 to obtain 3.

Note for benefit under 35 USC 119 and 120, there must be clear support (description and enablement) for claims instantly rejected herein as was set forth in *In re Scheiber* 199 USPQ 782; *In re Lukach*, 169 USPQ 795; *In re Gostelli*, 10 USPQ 2nd 1614; *Kawai v. Metlesics* 178 USPQ 159.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is (703) 305-1880. The examiner can normally be reached on Monday thru Friday from 9:00 AM to 5:30 PM.

The fax phone number for this Group is (703) 308-4734 for "unofficial" purposes and the actual number for **OFFICIAL** business is **308-4556**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

  
Brenda Coleman  
July 26, 2001